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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,304	02/20/2004	Norman Herron	UC0412USNA	7825

23906 7590 12/06/2006

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EXAMINER

NOLAN, JASON MICHAEL

ART UNIT PAPER NUMBER

1626

DATE MAILED: 12/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/783,304

Applicant(s)

HERRON ET AL.

Examiner

Jason M. Nolan, Ph.D.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 9, 11-16 and 24 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 6, 7, 17-20, 22, 23 and 25 is/are rejected.
- 7) ☒ Claim(s) 3-5, 8, 10 and 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-25 are pending; of which, **Claims 1, 8 & 17** have been amended.

Claims 26-37 are cancelled.

Response to Amendment

Applicants' amendments to **Claims 1, 8, & 17** have been considered. It appears that the amendment at the end of the Claims: "wherein the compound bears at least one crosslinkable group." is unnecessary because the substituent **R¹** is required to have a crosslinkable group attached to the aryl, heteroaryl, fluoroaryl, or fluoroheteroaryl according to its definition.

Response to Arguments

Applicants' arguments, see Amendment – After Non-Final Rejection, filed 9/21/2006, with respect to the restriction/election and expansion of search have been fully considered and are persuasive. The objection of **Claims 1-2 (in part), 4-8 (in part), 10-15, and 17-25 (in part)** for containing non-elected subject matter has been withdrawn. The full scope of the compounds according to Formulae (I), (III), & (IV) has been examined.

Applicants' arguments with respect to **Claims 1, 2, 4, 5, 8, 10-12, 17-18, and 20-21**, rejected under 35 U.S.C. § 112, second paragraph, as being indefinite have been considered and are found persuasive. The rejections are withdrawn.

Applicants' arguments with respect to **Claims 1-25**, provisionally rejected on the ground of nonstatutory double patenting over **Claims 1-21** of copending Application No. **10/782,357** have been considered and are found persuasive. The rejection is withdrawn.

Art Unit: 1626

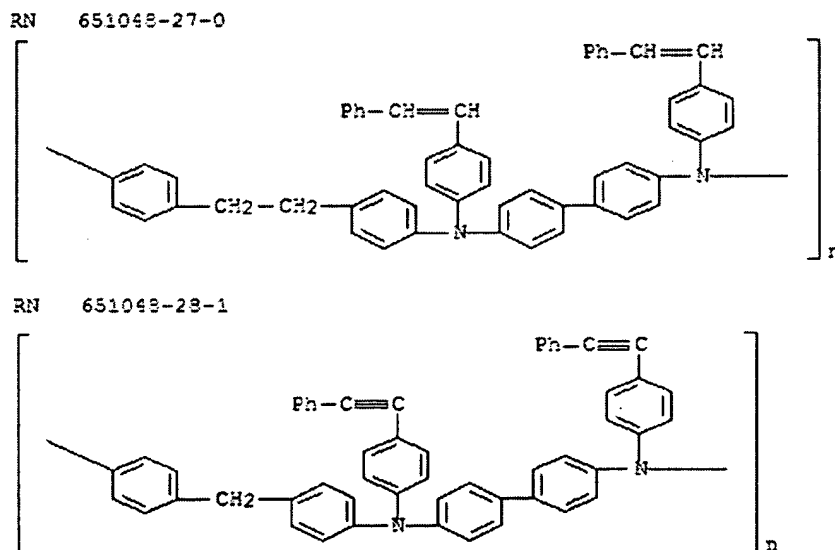
Applicants' arguments with respect to **Claims 1-2, 6-8, 10, 12, 13 & 17-20**, rejected under 35 U.S.C. § 102(b) as being anticipated by Schmitz *et al.* and Tokoli *et al.* been considered and are found persuasive. The rejections are withdrawn.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

For prior art determination, the interpretation of the Claim language is understood such that R^1 is selected from aryl or heteroaryl (each may be substituted by fluorine) and the aryl or heteroaryl bears a crosslinkable group. Therefore, for example, in formula (I): the compound contains two R^1 groups so an art rejection must contain two crosslinkable groups, as is the case below.

Claims 1, 2, 6, 7, 17-20, 23 & 25 are rejected under 35 U.S.C. 102(a) as being anticipated by Hirose *et al.* (JP 2004030942 A2, published 1/29/2004). Taught in the Japanese Patent by Hirose are the compounds RN 651048-27-0 and RN 651048-28-1; in which R^1 contains a crosslinkable group and E is $C(R^5R^6)$:



Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 22 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Said claim recites the language “comprising” and the scope of this term is unclear. The transitional term “comprising”, which is synonymous with “including,” “containing,” or “characterized by,” is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See: e.g., *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) (“Comprising” is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.); *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) (“comprising” leaves “the claim open for the inclusion of unspecified ingredients even in major amounts”).

Claim Objections

Claims 2, 10 & 18 are objected to because of the following informalities:

hydrogen is listed as a substituent for the aromatic groups as claimed; hydrogen is not a substituent and should be removed from the list. Appropriate correction is required.

Claims 1, 8, & 17 are objected to because of the following informalities: It

appears that the amendment at the end of the Claims: "wherein the compound bears at least one crosslinkable group." is unnecessary because the substituent R^1 is required to have a crosslinkable group attached to the aryl, heteroaryl, fluoroaryl, or fluoroheteroaryl according to its definition. Appropriate correction is required: the amendments should be deleted.

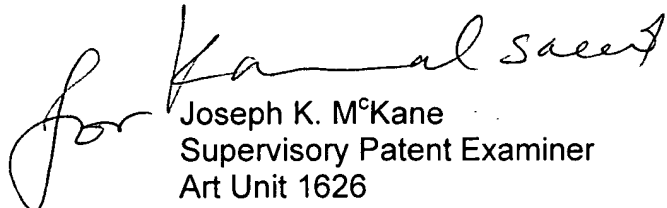
Claims 3-5 & 21 are objected to as being dependent upon a rejected base **Claim 1**, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 1626

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jason M. Nolan, Ph.D.** whose telephone number is **(571) 272-4356** and electronic mail is **Jason.Nolan@uspto.gov**. The examiner can normally be reached on Mon - Fri (9:00 - 5:30PM). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Joseph M^cKane** can be reached on **(571) 272-0699**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jason M. Nolan, Ph.D.
Examiner
Art Unit 1626


Joseph K. M^cKane
Supervisory Patent Examiner
Art Unit 1626
Date: November 28, 2006